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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,440	12/05/2003	Daniel A. Henderson	3052/112	9387

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Robert K. Tendler
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Boston, MA 02110

EXAMINER

ANWAH, OLISA

ART UNIT PAPER NUMBER

2614

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,440

Applicant(s)

HENDERSON, DANIEL A.

Examiner

Olisa Anwah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-449 is/are pending in the application.
- 4a) Of the above claim(s) 1-363 and 365-417 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 364 and 418-449 is/are rejected.
- 7) ☒ Claim(s) 448 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

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DETAILED ACTION

Claim Objections

1. Claim 448 is objected to because the term paging in line 10 lacks proper antecedent basis. Appropriate correction is required.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 448 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 35 of copending Application No. 11/050,370. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims require:

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For use in a wireless communication system including a wireless unit, having a sound output device, a CPU, a memory, and a method for generating a sound comprising the steps of:

storing sound data and caller identifying data of a potential communicant in a database record in memory in the wireless unit;

using the wireless unit to receive a wireless signal containing at least one caller identifying data;

using the CPU to determine whether caller identifying data received in the wireless paging signal matches caller identifying data stored in the memory; and

using the sound output device to generate a sound using a sound output device when it is determined that the received caller identifying data matches stored caller identifying data of the potential communicant.

Note: This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 364, 422 and 427 are rejected under 35 U.S.C. § 102(e) as being anticipated by Richardson et al, U.S. Patent No. 5,459,458 (hereinafter Richardson).

Regarding claim 364, Richardson discloses for use in a wireless communication system including a wireless unit, having; an output member, a CPU, a memory, and a method for alerting page-receiving communicant, comprising the steps of:

storing caller identifying data of a potential page-
originating communicant in a database record in memory;

using the wireless unit to receive a wireless paging signal containing at least one of the caller identifying data;

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using the CPU to determine whether at least one of the caller identifying data of the potential page-originating communicant received matches caller identifying data stored in the database record recorded in memory; and

using the CPU to alert the operator on the output member when it is determined that at least one of the caller identifying data matches stored caller identifying data of the potential page-originating communicant (see Figure 5).

Regarding claim 422, see the abstract of Richardson.

Regarding claim 427, see Figure 2 of Richardson.

6. Claim 364, 420, 421, 425-427, 430, 431, 448 and 449 are rejected under 35 U.S.C. § 102(e) as being anticipated by Wong et al, U.S. Patent No. 5,394,140 (hereinafter Wong).

Regarding claim 364, Richardson discloses for use in a wireless communication system including a wireless unit, having; an output member, a CPU, a memory, and a method for alerting page-receiving communicant, comprising the steps of:

storing caller identifying data of a potential page-originating communicant in a database record in memory;

using the wireless unit to receive a wireless paging signal containing at least one of the caller identifying data;

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using the CPU to determine whether at least one of the caller identifying data of the potential page-originating communicant received matches caller identifying data stored in the database record recorded in memory; and

using the CPU to alert the operator on the output member when it is determined that at least one of the caller identifying data matches stored caller identifying data of the potential page-originating communicant (see Figure 4).

Regarding claim 420, see Figure 4.

Regarding claim 421, see Figure 4.

Regarding claim 425, see Figure 4.

Regarding claim 426, see Figure 4.

Regarding claim 427, see Figure 1.

Regarding claim 430, see Figure 4.

Regarding claim 431, see Figure 4.

Regarding claim 448, Wong discloses for use in a wireless unit, having a sound output device, a CPU, and a memory, a method for generating a sound comprising the steps of:

storing sound data and caller identifying data of a potential communicant in a database record in memory in the wireless unit;

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using the wireless unit to receive a wireless signal containing at least one caller identifying data;

using the CPU to determine whether caller identifying data received in the wireless paging signal matches caller identifying data stored in the memory; and

using the sound output device to generate a sound when it is determined that the received caller identifying data matches stored caller identifying data of the potential communicant (see Figure 4).

Regarding claim 449, see Figure 4.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 418, 419, 423, 424, 428, 429 and 432-447 are rejected under 35 U.S.C. § 103(a) as being unpatentable over

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Richardson in view of Reed et al, WIPO Publication No. 91/03885 (hereinafter Reed).

Regarding claim 432, Richardson discloses a method for displaying identification information on a wireless personal communicator, comprising the steps of:

pre-storing identification information representative of at least one potential communicant in a memory contained in the wireless personal communicator;

pre-storing numeric caller identifying data associated with said pre-stored identification information representative of at least one potential communicant in a memory contained in the wireless personal communicator;

receiving a wireless signal at the wireless personal communicator containing the at least one of caller identifying data related to a calling party;

comparing at least one of the received caller identifying data with the pre-stored numeric caller identifying data to determine if there is a match between at least one of the received caller identifying data and the pre-stored numeric caller identifying data; and

displaying the pre-stored identification information representative of a calling party on a display in the wireless personal communicator when it is determined that at least one of

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the received caller identifying data received matches the pre-stored numeric caller identifying data of the at least one potential communicant (see Figure 5).

Still on the issue of claim 432, Richardson fails to teach the identification information is an image. All the same, Reed shows this feature (see Figure 3). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Richardson with the graphics of Reed. This modification would have improved the system's convenience by providing other pertinent information that may assist the virtual page user in determining the identity of the page originator as suggested by Richardson (see column 8).

Regarding claim 433, see Figure 5 of Richardson.

Regarding claim 434, see Figure 5 of Richardson.

As per claim 435, Richardson teaches at least one of the caller identifying data received is displayed (see Figure 5). Richardson fails to teach at least one of the caller identifying data received is displayed along with the pre-stored image representative of a calling party. All the same, Reed shows this feature (see Figure 3). Consequently, it would have been obvious

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to one of ordinary skill in the art at the time the invention was made to modify Richardson with the graphics of Reed. This modification would have improved the system's convenience by providing other pertinent information that may assist the virtual page user in determining the identity of the page originator as suggested by Richardson (see column 8).

Claim 436 is rejected for the same reasons as claim 435.

Regarding claim 437, see Figure 4 of Richardson.

Regarding claim 438, see Figure 4 of Richardson.

Regarding claim 439, Richardson discloses a method for displaying identification information in a wireless personal communicator, comprising the steps of:

- pre-storing identification information representative of at least one potential communicant in a memory contained in the wireless personal communicator;

- pre-storing alpha-numeric caller identifying data associated with pre-stored identification information representative of at least one potential communicant in a memory contained in the wireless personal communicator;

- receiving a wireless signal at the wireless personal communicator containing at least one caller identifying data;

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comparing the at least one of caller identifying data related to a calling party with the pre-stored alpha-numeric caller identifying data to determine if there is a match between at least one of the received caller identifying data and the pre-stored alpha-numeric caller identifying data; and

displaying a pre-stored identification information representative of the at least one potential communicant on a display in the wireless personal communicator when it is determined that at least one of the caller identifying data received matches the pre-stored alpha-numeric caller identifying data of the at least one potential communicant (see Figure 5).

Still on the issue of claim 439, Richardson fails to teach the identification information is an image. All the same, Reed shows this feature (see Figure 3). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Richardson with the graphics of Reed. This modification would have improved the system's convenience by providing other pertinent information that may assist the virtual page user in determining the identity of the page originator as suggested by Richardson (see column 8).

Regarding claim 440, see Figure 5 of Richardson.

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Regarding claim 441, see Figure 5 of Richardson.

Claim 442 is rejected for the same reasons as claim 435.

Claim 443 is rejected for the same reasons as claim 436.

Claim 444 is rejected for the same reasons as claim 437.

Claim 445 is rejected for the same reasons as claim 438.

As for claim 446, Richardson does not clearly show the image is at least one of: iconographic data, logo data, data representative of the calling party, photo image, video image data and other graphic image data. All the same, Reed shows this feature (see Figure 3). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Richardson with the graphics of Reed. This modification would have improved the system's convenience by providing other pertinent information that may assist the virtual page user in determining the identity of the page originator as suggested by Richardson (see column 8).

Claim 447 is rejected for the same reasons as claim 446.

As for claim 418, Richardson teaches the output member is a display member (see Figure 4). Richardson does not explicitly state that the method for alerting the page-receiving

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communicant includes the step of displaying an image. All the same, Reed shows this feature (see Figure 3). Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Richardson with the graphics of Reed. This modification would have improved the system's convenience by providing other pertinent information that may assist the virtual page user in determining the identity of the page originator as suggested by Richardson (see column 8).

Claim 419 is rejected for the same reasons as claim 446.

Claim 423 is rejected for the same reasons as claim 418.

Claim 424 is rejected for the same reasons as claim 419.

Claim 428 is rejected for the same reasons as claim 418.

Claim 429 is rejected for the same reasons as claim 419.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be

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reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

O.A.

Olisa Anwah
Patent Examiner
October 16, 2006

Olisa Anwah